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10/777,478	02/12/2004	Nicola Funnell	1578.607 (11758-US-PAT)	2295
44208	7590	02/09/2011	EXAMINER MANOHARAN, MUTHUSWAMY GANAPATHY	
DOCKET CLERK Kelly-Krause PO BOX 12608 DALLAS, TX 75225			ART UNIT 2617	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/777,478	FUNNELL, NICOLA
	<b>Examiner</b>	<b>Art Unit</b>
	MUTHUSWAMY MANOHARAN	2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 09 December 2010.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 and 7-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3 and 7-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 1-3** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 1 the claimed limitation, "receiving a SIB relating to measurement information type 12 (SIB 12) which relates to connected mode and then receiving a SIB relating to measurement information of type 11 (SIB 11) which relates to idle and connected mode, at least one the SIBs including an SIB IE, each IE, each IE related to cell information list and having associated system", was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The dependent claims 2-3 are also rejected as they depend on the rejected base claim 1.

Correction and/or clarification is/are requested.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 7, the recitation, "receiving at least one each of a system information of type SIB 12 and of a system information of type SIB 11; determining thereafter if each of the SIB 11 and SIB 12 includes a same one" was not enabling.

Receiving at least one each of a system information of type SIB 12 and of a system information of type SIB 11 could include either SIB 11 or SIB 12. If only one of SIB 11 and SIB is received, then how one could determine thereafter if each of the SIB 11 and SIB 12 includes a same one.

Correction and/or clarification is/are requested.

### ***Response to Arguments***

Applicant's arguments filed 12/9/2010 have been fully considered but they are not persuasive.

Applicant argues that (Page 6) that SIB 11 relates to both the idle and connected modes. And, the active, candidate, and handover-cells cannot, therefore, correspond to SIB 11 and/or SIB 12. The amended claims therefore recite a method in which SIB 11 and SIB 12 are different than the Examiner's asserted equivalency".

The active, candidate and handover cells correspond to the cell information list(Tohono) and SIB 11 and SIB 12 also includes cell information list (3GPP) and therefore 3GPP in view of Tohono teaches the claimed limitation.

Applicant argues that “Applicant’s further note that the claims state that SIB relates to measurement information of type 11 and type 12. This differs with the mere reference in Tohono to active and candidate cells”.

Examiner respectfully disagrees. The active, candidate and handover cells correspond to the cell information list(Tohono is performing measurements, P[0056]) and SIB 11 and SIB 12 also includes cell information list (3GPP) and therefore 3GPP in view of Tohono teaches the claimed limitation.

Applicant further argues that Tohono fails to disclose receiving SIB 12 and then SIB 11 ...as now recited.

The above amendment is not in the specification as discussed above in the new rejection (112 first paragraph).

Applicant argues that(Page 7), Tohono fails to disclose SIB 11 and SIB 12 are both received first, before later determining if the same IE type is included and acting upon the system information associated with the identified same IE types according to a predefined order.

Examiner respectfully disagrees. The primary reference, 3GPP teaches that System information block of type 11 and 12. Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically

satisfies the claimed limitation responding to a determination that the same IE type is included by acting upon the system information associated with the identified same type according to the predefined order.

In Tohona reference, active cell is searched first and then hand-over destination candidate cell, as seen from Paragraphs [0056-0059]. It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 of Tohona,

Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the predefined order where the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 3GPP (TS 25.331 v3.16.0 (2003-9)) (hereinafter Reference (A)) in view of Tohono (US 2003/0040312).**

Regarding **claim 1**, Reference (A) teaches a method for handling system information in a user equipment device configurable for use in a mobile telecommunications system, method comprising:

receiving a SIB relating to measurement information of type 12 (SIB 12) (“system Information Block type 12 (SIB 12)” in Section 8.1.1.6.12) which relates to connected mode (line 1 in Section 8.1.1.6.12), and then receiving a SIB relating to measurement information of type 11 (SIB 11) (“system Information Block type 11 (SIB 11)” in Section 8.1.1.6.11) which relates to idle and connected mode (line 2 ,14, and 22 in Section 8.1.1.6.11), at least one the SIBs including an SIB IE, each IE (lines 29-31 in Section 8.1.1.6.11), each IE related to cell information list (lines 7-9, lines 24-28 and lines 31-32 in Section 8.1.1.6.11; lines 14-53 in Section 8.1.1.6.12) and having associated system information (“measurement identity”, line 20 in Section 8.1.1.6.11 );

determining thereafter if a same information element is included in each of the SIB 11 and the SIB 12 (lines 49-50 in Section 8.1.1.6.11 and section 8.1.1.6.12).

Reference (A) did not teach specifically providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE

type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order.

However, Tohono teaches in an analogous art method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona,

Since Tohono is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the predefined order where the predefined order being to act on system information associated with an IE in

a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12)).

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that the same IE type is included by acting upon the system information associated with the identified same IE types according to the predefined order in order to provide an efficient search strategy.

Regarding **claim 2**, Reference (A) teaches a method according to claim 1, wherein the system information block information element is selected from the following system information block information elements; an information element relating to an intra-frequency cell information list (Section 10.3.7.33), an information element relating to an inter-frequency cell information list (Section 10.3.7.13) and an information element relating to an inter-Radio Access network (RAT) cell information list (Section 10.3.7.23).

Regarding **claim 3**, Reference (A) teaches a method according to claim 1 wherein the system information block information element is any of the following: "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

Regarding **claim 7**, Reference (A) teaches a method for handling system information in a user equipment device, the device enable for use in a UMTS mobile telecommunications system, the system comprising a network of a plurality of cells: receiving at least one each of system information of type System information Block (SIB) 12 and system information of type SIB 11; determining thereafter if each of the SIB 11 and SIB 12 includes a same one or more information elements (IEs) relating to any of "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-frequency cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12; Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Reference (A) did not teach specifically a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order.

However, Tohono teaches in an analogous art a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system

information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona, Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies requirements of the condition).

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the

SIBs; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order in order to provide an efficient search strategy.

**Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reference (A) in view of in view of Tohono (US 2003/0040312) and Laitinen et al. (hereinafter Laitinen) (US 6765891).**

Regarding **claim 8**, Reference (A) teaches receiving two system information blocks (SIBs), each SIB comprising at least one information element (IE) that is related to a cell information list and where each SIB is a different type of SIB; determine if a same IE is included in each of one SIB (a first SIB) and other SIB (a second SIB) relate to cell information list IE (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12; Section 8.1.1.4, lines 1-3; Section 8.5.23, lines 6-15).

Reference A did not teach specifically a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is not included in each SIB 11 and SIB 12 by acting upon the system information associated with SIB IEs while refraining from using

the predefined order; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

However, Tohono teaches in an analogous art a method of providing a predefined order for applying system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

(active cell is searched first and then hand-over destination candidate cell, Paragraphs [0056-0059]; Note: It is well known in the art that cell information list corresponding to the active cell reads on SIB 11 and cell information list corresponds to handover destination candidate cell reads on SIB 12 from Tohona. Since Tohona is applying the system information associated with the active cell (reads on SIB 11) first before applying the system information associated with the handover destination candidate cell this automatically satisfies the requirements of the claimed condition.

Therefore, it would be obvious to one of ordinary skill in the art at the time of invention to use the system information associated with system information block (SIB) information elements (IEs), the predefined order being to act on system information associated with an IE in a SIB of type 11 (SIB 11) and then to act upon system information associated with a same type of IE in a SIB of type 12 (SIB 12); responding to a determination that the same IE type is included in only one of the SIBs by applying an IE from the associated one of the SIBs; and responding to a determination that each of the SIB 11 and SIB 12 includes the same IEs by acting upon the system information associated with the SIB IE in SIB 11 and then applying the system information associated with corresponding SIB IE in SIB 12, according to the predefined order .

The combinations of Reference (A) and Tohono teaches all the particulars of the claim 1, except a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations. However, Laitinen teaches in analogous art, a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the operations (Col. 4, lines 29-40).. Therefore, it would be obvious to one of ordinary skill in the art at the time invention to implement the method using a a microprocessor connected to memory, the memory comprising software disposed therein, the software configured to be run by the microprocessor, where the microprocessor running the software is configured to carry out at least the

operations. This modification provides a method of implementation of Radio Resource Control protocol for the UE-UTRAN radio interface.

Regarding **claim 9**, Reference (A) teaches the system information block information element is any of the following: "intra-frequency cell info list", "inter-frequency cell info list" and "Inter-RAT cell info list" (lines 28-30 in Section 8.1.1.6.11 and lines 8-10 in section 8.1.1.6.12).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MUTHUSWAMY MANOHARAN whose telephone number is (571)272-5515. The examiner can normally be reached on 6:30am-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Muthuswamy G Manoharan/  
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